

Appl. No. 10/722,805
Amdt. dated May 4, 2006
Reply to Office Action of March 7, 2006

REMARKS/ARGUMENTS

Claims 1, 2 and 5 - 27 are presented for the Examiner's consideration. Pursuant to 37 C.F.R. § 1.111, reconsideration of the present application in view of the foregoing amendments and the following remarks is respectfully requested.

I. 35 U.S.C. §112 Rejection

Claim 1 stands rejected under 35 U.S.C. §112 second paragraph. The Applicants have amended claim 1 as requested by the Examiner removing the basis for the rejection.

II. 35 U.S.C. §103 Rejections

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference, or combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the Applicants' disclosure. See MPEP §2142 citing *In re Vaeck*, 947 f.2d 488, 20 USPQ2d 1438 (Fed Cir. 1991).

Claims 1, 2, 5-19, and 22-26 stand rejected under 35 U.S.C. §103(a) as being obvious over FitzSimons et al., US 6,899,250 in view of Compton, US 4,487,376. FitzSimons et al. discloses a wet and dry towel dispenser having an elongated container 12 with a slot 24 for accessing the dry towels 20 in the dry towel compartment 14. FitzSimons et al. specifically teaches that the dispenser should be portable and should protect the dry towels from moisture and debris. For example, at column 1, lines 31 – 35, FitzSimons et al. states:

The existing wet and dry towel dispensers, however, do not provide the wet and dry towels in a convenient package that can easily be packed or stored (e.g., in a diaper bag or in a drink holder of an automobile).

At column 4, lines 43 – 50, FitzSimons et al. states:

Although various sizes and dimensions are contemplated, the dispenser 10 is preferably sized to be portable and easily stored. For example, the diameter of the container 12 can have the dimensions corresponding to a drink holder in an automobile. The coaxial arrangement of the dry towels 20 and the wet towels 22 within the elongate container 12 maximizes space and facilitates the portability of the dispenser 10.

At column 3, lines 51 – 60, FitzSimons et al. states:

The dry towel passage 24 is preferably a slot located along the outer wall 32 and in this embodiment, extending substantially the length of the container 12. In one embodiment, a lip or hood portion 36 extends from the outer wall 32 of the container over the dry towel passage 24 to prevent debris or moisture from contaminating the dry towels 20 (FIG. 1A).

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In another embodiment, a hinged cover (not shown) is closed over the dry towel passage 24 when it is not in use and is opened to access the dry towels 20.

When considering the teachings of the reference as a whole, it is clear that FitzSimons et al. is concerned with portability and protecting the dry towels from damage during the portable usage. Furthermore, a slot for the dry towel passage as specified by FitzSimons et al. is defined to be a *narrow opening*.¹ Therefore, increasing the dispensing opening to such a large extent as suggested by the Examiner (up to 100%) is clearly contrary to the teachings of FitzSimons et al., and one of ordinary skill in the art would not be motivated to make the modification as suggested by the Examiner. The paper towel roll would be exposed to such a large extent that it would become damaged or dirty, rendering the dispenser unsuitable for the intended portable use.

Furthermore, the Examiner's suggested modification would render FitzSimons et al. inoperable. For example, if the slot 24 is enlarged to expose 100% of the roll's exterior surface as suggested, there would no longer be an elongated container - i.e., there would no longer be any sidewall to the container only a top and a bottom held together by nothing. As such, the container element of FitzSimons et al. would be obviated by the proposed modification, rendering the FitzSimons et al. dispenser inoperable. If the slot is enlarged significantly to expose 50% of the roll's exterior surface, the dry paper roll would either fall out of the container in the embodiments shown in Figures 4 and 6, or not be protected during portable use. With at least 50% of the roll's exterior surface exposed, the slot 24 would be at least as large as $\frac{1}{2}$ the circumference of the dry roll. As such, the dry roll would fall right out of the modified slot when the dispenser is placed into a diaper bag, being moved around, or the roll would be pulled out of the slot during dispensing, rendering the dispenser inoperable for its intended use.

The Examiner has cited Compton for exposing 100 percent of the roll as old and well known in the art. Compton discloses a braking device for a paper towel roll to enhance dispensing in order to facilitate tearing a sheet by breaking the roll with the breaking device. While the majority of the roll's exterior surface is exposed in Compton, Compton does not teach or suggest having either more or less of the roll's exterior surface exposed to enhancing dispensing. Compton is silent with respect to how much of the roll's exterior surface should be exposed. Thus, Compton does not provide the motivation to expose the specific ranges of the roll's exterior surface as claimed by the Applicants.

The Applicants' specification at page 4, lines 18-20, identifies exposing a specific percentage of the roll's exterior surface to enhance dispensing, for locating the tail, or to enable

¹ The American Heritage College Dictionary Third Edition Copyright 2000 defines a slot to be a narrow opening, groove, or slit.

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rewinding of the roll if an excess amount has been dispensed. There is no teaching or suggestion in Compton, Fitzsimons et al., or the combination of the two to expose the claimed ranges for the purposes as taught by the Applicants. Thus, the suggestion to make the Examiner's modification does not come from the prior art, but instead the Applicants' disclosure has been used with hindsight as a blueprint to find the elements in the prior art.

Dependent claims 20, 21, and 27 stand rejected under 35 U.S.C. §103(a) as obvious over FitzSimons et al., in view of Compton, and further in view of Bando U.S. 6,206,221. The proposed combination does not cure or supply the deficiency with respect to the Examiner's obvious rejection of independent claim 1. As such, these claims are allowable for the reasons discussed for claim 1.

For the reasons stated above, it is respectfully submitted that all of the presently presented claims are in form for allowance. Furthermore, since all of the withdrawn claims depend directly or indirectly from claim 1, they are also in a condition for allowance. Please charge any prosecution fees which are due to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875. The undersigned may be reached at: (920) 721-7760.

Respectfully submitted,

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